

## REMARKS

Applicant submits this Amendment in response to the Office Action mailed on March 17, 2005. The Office Action was a final rejection of all pending claims. Applicant submits with this Amendment a Request for Continued Examination (RCE) of this application.

Claims 75 to 89 have been canceled. Claims 94 to 96 have been withdrawn as not being directed to an elected invention. Applicant expressly reserves the right to present these or similar claims in a future patent application claiming priority from the present application. Independent claim 90 has been amended to add the feature of 10 seconds or less. New claim 97 has been added calling for within 5 seconds. Support in the specification for these amendments is found several locations in the specification, such as on page 4, lines 16 to 20. No new matter is added by the present amendments.

## REJECTIONS OF THE CLAIMS

### I. Rejection under 35 U.S.C. §102(b)

The Examiner has rejected claims 75 to 89 as being anticipated by a practice that people often do, such as, as stated by the Examiner in the Office Action in paragraph 2 on page 3, "be in a mist environment, such as walking in a foggy morning, take a sauna bath." Applicant traverses the rejection of the claims on this ground.

Applicant submits that these claims are patentably distinguishable over this practice cited by the Examiner, as argued in the Amendment filed on December 9, 2004. However, to expedite prosecution of this application, Applicant has canceled claims 75 to 89.

Applicant expressly reserves the right to present such claims in a future application claiming priority from the present application.

II. Rejections under 35 U.S.C. §103(a)

A. Rejection of claims 75 to 89 in view of Embleton and Laibovitz

The Examiner has rejected claims 75 to 89 as being obvious under 35 U.S.C. §103(a) over Embleton et al (WO 97/23177) in view of Laibovitz et al (U.S. Patent No. 5,997,518). Applicant traverses the rejection of the claims on this ground.

For the reasons discussed in the Amendment of December 9, 2004, Applicant submits claims 75 to 89 are patentable over the combined disclosures of Embleton and Laibovitz. However, to expedite prosecution of this application, Applicant has canceled claims 75 to 89. Applicant expressly reserves the right to present such claims in a future application claiming priority from the present application.

B. Rejection of claims 90 to 93 in view of Junkel

The Examiner has rejected claims 90 to 93 under 35 U.S.C. §103(a) as being obvious in view of the disclosure of Junkel, U.S. Patent No. 5,620,633. Applicant traverses the rejection of these claims on this ground.

1. The disclosure of Junkel is not pertinent to the present invention  
Junkel discloses a portable misting device for sunbathers and others involved in athletic pursuits. The device provides a cooling air current with atomized liquid mist, such as water, and directs the cooling air current in a direction set by a user. The device of Junkel, because it is meant to “combat the elements of heat and dehydration attendant with athletic

activities and/or prolonged exposure to the sun" (see column 1, lines 15-19), is presumably meant to be used by directing such moist air current into an area occupied by a sunbather or one engaged in athletic pursuits or directly onto the surface of the body of such individual.

In contrast to Junkel, the present invention is a method for moisturizing the surface of the eye. Applicant submits that Junkel is not pertinent to the present application. Junkel does not disclose moisturizing the surface of the eye but rather pertains to cooling the body of one suffering from heat or dehydration due to sun exposure or sweating due to athletic endeavors. The Examiner states, in the Office Action, in paragraph 5, on page 5, that Junkel does not disclose applying the mist to the face or to a subject in need of moisturizing the eye.

Applicant submits that the rejection of claims 90 to 93 in view of Junkel is improper because the method of the present invention is neither disclosed nor suggested by Junkel. There is no disclosure or suggestion in Junkel to direct a mist to the eyes, or if the mist is directed to the eyes, to keep the eyes open so that the mist is delivered to the surface of the eye. There is no disclosure or suggestion in Junkel that the mist is useful for moisturizing the eye. Applicant submits that the disclosure of Junkel is not relevant to the present invention and requests the Examiner to reconsider and to withdraw the rejection of claims 90 to 93 on this ground.

2. Even if Junkel is sufficient to establish a *prima facie* case of obviousness has been made, the rejection is rebutted

Applicant submits that the Examiner has not established a *prima facie* case of obviousness and that the claims are patentable over the disclosure of Junkel. However, assuming that the Examiner has indeed established that the claims are *prima facie* obvious in view of

Junkel, Applicant submits that the declarations filed on January 30, 2004 are sufficient to overcome such *prima facie* obviousness.

Previously submitted Declarations of Dr. Darwin Liao and of Dr. William Mathers provided data to show that the method of the invention was found to be more effective and more well tolerated by users than are prior art methods of moisturizing the eye (unexpected advantageous properties), and overcomes the long-standing problem of poor patient compliance in moisturizing eyes that is due to discomfort in applying eye drops or inability to apply eye drops, such as in elderly patients with limited mobility or flexibility.

The previously submitted Declaration of Dr. Philip Paden established that the invention is contrary to accepted ophthalmology doctrine in the direct application of water to moisturize the eye. This Declaration was accompanied by a CD presentation that diagrammatically shows how the invention, when practiced by application of a mist, restores the osmolarity of a tear film in a person suffering from dry eye to a comfortable physiologic level, and how such a mist may be used to moisten the eye using water, in contrast to previously accepted ophthalmologic dogma.

The previously submitted article in *Exchange & Commissary News*, 43(1):6 (January 15, 2004) establishes that the product embodied by the claims is enjoying commercial success. This is a secondary evidence of non-obviousness. See MPEP 716.03. In this case, the United States military is using the commercial embodiment of the invention to help troops moisturize their eyes in a very demanding situation, that of desert conditions. Applicant submits, accordingly, that this article is very strong evidence of nonobviousness.

In view of the above, Applicant respectfully submits that, even if a prima facie case of obviousness can be made against the present claims, Applicant has presented sufficient evidence to rebut any such rejection for obviousness and requests the Examiner to reconsider and to withdraw the rejection of the claims on this ground.

3. The present amendments to the claims further distinguish over the prior art

Applicant has amended independent claim 90 to add a new feature that the administration of the spray of water is within a period of 10 seconds or less. New claim 97 calls for 5 seconds or less. Applicant submits that this feature in claim 90 and in 97 further patentably distinguishes over the disclosure of Junkel.

For the above reasons, Applicant respectfully requests the Examiner to reconsider and to withdraw the rejection of claims 90 to 93 as being obvious in view of Junkel.

#### Conclusion

Applicant respectfully requests the Examiner to withdraw the rejection of the claims and to issue a notice of allowance for this application.

Respectfully submitted,



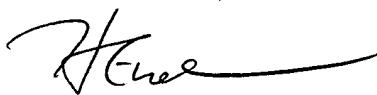
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Co-submission: Request for Continued Examination

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 12, 2005.

Dated: April 12, 2005

  
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